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In re Application of	:	OFFICE OF PETITIONS
Brugger et al.	:	
Application No. 10/796913	:	DECISION ON PETITION
Filing Date: 03/08/2004	:	UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. T4342-14198US18	:	

This is a decision on the "Petition Under 37 CFR 1.78(a)(3)," filed January 16, 2008, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the concurrently filed Amendment.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition does not comply with items (1) and (3).

As to item (1), the reference to add the above-noted, prior-filed application, no. 09/061,647, on page one following the first sentence of the specification is not acceptable as drafted since it improperly incorporates by reference the prior-filed application(s). An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (*see* 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would

not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. *See Dart Industries v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). *Note* MPEP §§ 201.06(c) and 608.04(b).

As to item (3), the priority claim was due within four months of filing the application or within 16 months of the earliest priority date claimed. Thereafter, a petition for acceptance of a delayed priority claim requires a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii), and the date the claim was filed was unintentional. The present petition is filed by a party, Petitioner herein, that became of record in the application on March 12, 2008, by virtue of a Power of Attorney executed by the assignee, NxStage Medical, Inc. Petitioner herein was not of record for the entire period between the date the claim was due under 37 CFR 1.78(a)(5)(ii), and the date the claim was filed. Moreover, the assignee of record, NxStage Medical, Inc., became the assignee by virtue of an assignment executed August 24, 2004, more than five (5) months after the filing date of the present application¹. As such, the Assignee is not in a position to know whether the entire period between the date the claim was due under 37 CFR 1.78(a)(5)(ii), and the date the claim was filed he date the claim was filed was unintentional. In view of the foregoing, there is a question whether Petitioner herein is in a position to know whether the entire delay between the date the claim was due and the date the claim was filed was unintentional.

Before the petition under 37 CFR § 1.78(a)(3) can be granted, a renewed petition and either an Application Data Sheet or a substitute amendment (complying with the provisions of 37 CFR 1.121 and 37 CFR 1.76(b)(5)), to correct the above matter, and a statement from a proper party, that the entire delay between the date the claim was due under paragraph (a)(2)(ii) of this section and the date the claim was filed was unintentional, are required.

Further correspondence with respect to this matter should be addressed as follows:

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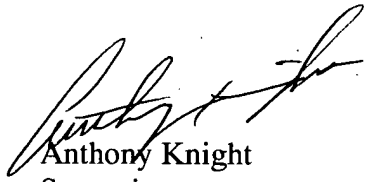
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¹ The Assignment was recorded in this Office on September 23, 2004.

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Any questions concerning this matter may be directed to attorney Derek Woods at (571) 272-3232.

A handwritten signature in black ink, appearing to read 'Anthony Knight', is written over the printed name.

Anthony Knight
Supervisor
Office of Petitions